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EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT PAPER NUMBER

2612

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,338

Applicant(s)

TERASAKI ET AL.

Examiner

LUONG T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005 and 13 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-11 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 12-17 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I, Figures 1-6, in the reply filed on 6/13/2005 is acknowledged.
2. Claims 3-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/13/2005.

Response to Arguments

3. Applicant's arguments filed on 11/29/2005 and 12/13/2005 have been fully considered but they are not persuasive.

In re pages 11-12 of the Amendment filed on 11/29/2005, Applicants argue that Figure 1-5 of Kleinschmidt et al. show a mobile phone, but Figure 6 only shows block diagrams of circuitry. Out of Figures 1-5, only Figure 2 shows camera CAM, and it does not show camera CAM "mounted to the phone body".

In response, regarding claim 1, the Examiner considers that Kleinschmidt et al. does disclose limitation "a video camera mounted to the phone body." Kleinschmidt et al. discloses a communication device K, which is a mobile phone, in Figure 5; and a camera mounted to the communication device K to record an image or make a film of the user (column 7, lines 20-25).

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It is noted that since Figure 6 shows a block diagrams of circuitry of a communication device (column 7, lines 44-67), the communication device K in Figure 5 also includes the circuitry of Figure 6. This indicates that “a camera” as disclosed in column 7, lines 20-25, corresponds to camera CAM in Figure 6.

In re pages 12-13, Applicants argue that Spitzer does not disclose the video camera part is mounted “so that a direction of the eye of the user and a direction for taking an image are parallel or approximately parallel when the arm is opened” as recited in claim 1.

In response, regarding claim 1, the Examiner considers that Spitzer does disclose this feature. Spitzer teaching camera 210 is mounted on the temple 205 of eyeglasses 250 so that the field viewed by the camera 250 overlaps the field viewed by the user (the direction of the eye of the user and a direction for taking image are approximately parallel), Figure 2, Column 4, Lines 46-65).

In re page 13, Applicants argue that Applicants find no teaching or suggestion in Kleinschmidt et al. of a communication device designed to remain concealed while in use. And it has not been shown that Spitzer can suggest modifying the Kleinschmidt et al. communication device to have every feature recited in claim 1.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Kleinschmidt et al. by the teaching of Spitzer in order to place the field of view of the camera in proximity to or convergent with the operator's field of view, so that the camera records the visual field observed by the user and allows the camera to have the same line of sight as the user's eye, without parallax error (Column 2, Lines 60-65).

Claim Objections

4. Claims 2, 13, 14, 17 are objected to because of the following informalities:

Claim 2 (line 19), claim 13 (line 4), "an eyepiece part side" should be changed to --the eyepiece part side--.

Claim 14 (line 4), claim 17 (line 3), "the speaker part" should be changed to --a speaker part--.

It is noted that claims 3-8 should be identified as "withdrawn" since claims 3-11 have been withdrawn from consideration as indicated in Paper mailed on 6/30/2005.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinschmidt et al. (U. S. Patent No. 6,085,112) in view of Spitzer (U. S. Patent No. 6,349,001).

Regarding claim 1, Kleinschmidt et al. discloses a mobile phone (communication device K, Figure 5, Column 6, Lines 64-67) provided with a video camera (camera CAM, Figure 6, Column 7, Lines 65-67) comprising:

a phone body having a wireless transmitting and receiving function of an image and sound (Figures 5-6, communication device K has communication interface Komm for transmitting audio and video, Column 8, Lines 60-67, Column 4, Lines 10-14, Column 5, Lines 35-40),

a virtual image optical display device for forming a virtual image on a retina of an eye of a user by passing image information from an image information driving part through an imaging optical system (display device BAV5, Figure 5, Column 7, Lines 1-43),

an arm foldably provided to the phone body through a hinge (foldable image display device BAV5, which is attached on an arm in Figure 5, Column 7, Lines 1-8),

an eyepiece part of the virtual image optical display device provided to the arm (an eyepiece part is included in image display BV5, Figure 5),

a video camera part (camera CAM, Column 7, Lines 23-25, 6-67, Figure 6) mounted to the phone body,

a length between a position of the phone body which is contact with the ear of the

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user and the hinge, an angle between the arm and the phone body when the phone is used, a length of the arm are determined so as to have ergonomically optimum relations with each other (Figure 5 shows a position when communication K is used, this position allows the user views an object at a comfortable visual distance, Column 7, Lines 15-23).

Kleinschmidt et al. fails to specifically disclose a video camera part mounted to the phone body so that a direction of the eye of the user and a direction for taking an image are parallel or approximately parallel when the arm is opened. However, Spitzer teaching camera 210 is mounted on the temple 205 of eyeglasses 250 so that the field viewed by the camera 250 overlaps the field viewed by the user (the direction of the eye of the user and a direction for taking image are approximately parallel), Figure 2, Column 4, Lines 46-65). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Kleinschmidt et al. by the teaching of Spitzer in order to places the filed of view of the camera in proximity to or convergent with the operator's field of view, so that the camera records the visual filed observed by the user and allows the camera to have the same line of sight as the user's eye, without parallax error (Column 2, Lines 60-65).

Allowable Subject Matter

7. Claims 2, 12-17 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 2, the prior art of the record fails to show or fairly suggest a mobile phone provided with a video camera, wherein an imaging optical system (i.e., optical system 4,

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Figure 1) of the virtual image optical display device (i.e., virtual image optical display device 2, Figure 1) is separate into an optical system (i.e., optical system 4a, Figure 1) on an image information driving part side and an optical system (i.e., optical system 4c, Figure 1) on an eyepiece part side via a folding part, the optical system on an eyepiece part side is mounted on the arm (i.e., arm 6, Figure 1) foldably provided to the phone body through the hinge, and the optical system on the image information driving part side and the image information driving part (i.e., image information driving part 3, Figure 1) are mounted in the phone body.

Claims 12-17 are allowable for the reason given in claim 2.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID L. OMETZ can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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03/01/06



DAVID OMETZ
SUPERVISORY PATENT EXAMINER